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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/227,350	01/08/99	NISHIUMI S	723-680

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EXAMINER	
LEWIS,D	
ART UNIT	**PAPER NUMBER**
2778	8

DATE MAILED: 08/31/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/227,350	Applicant(s) Nishiumi et al.
	Examiner David L Lewis	Group Art Unit 2778

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *11-33* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *11-33* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *2,5-7*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Title: Operating Device and Image Processing System Using Same

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. **Claims 11, 13, 14, 17-22, 25-27, 30, and 31 are rejected under 35 U.S.C. 102(a) as being anticipated by Garrido (5451053).**

3. **As in claim 11, Garrido teaches** for use with a video game system console having a game program executing processing system for executing said video game program to create a display simulating a three dimensional world, and a portable storage device having a memory for storing video game instructions including instructions for causing said game program executing processing system to display a player controlled object and for causing said player controlled object to move at various different speeds, a player controller, **column 1 lines 6-29, column 6 lines 4-5,** comprising: a joystick control member, **figure 1 item 50**; detecting circuity for generating joystick data indicative of the amount of joystick angular inclination and inclined direction, **column 1 lines 20-28, column 5 lines**

55-68; processing circuity for responding to a command from said game program executing processing system, whereby said game program executing processing system is operable to determine the direction and speed for said player controlled object, **column 6 lines 20-36**. Said video game controller as taught by Garrido for use within a video game system is a reconfigurable video game controller with all the advantages of the prior art, **column 1 lines 45-56. As in claims 19 and 27**, Garrido teaches of the invention as applied to claim 11 above, and further, Garrido teaches of a memory media for storing video game instructions and graphics data; a connector for coupling said video game instructions and said graphics data from said memory media to said video game system console, **figure 1 item 64, column 6 lines 1-6,** wherein as in **claim 29** said distinctive motion characteristic is inherent to a reconfigurable video game controller, said motion being distinct for each of the plurality of possible video game configurations.

4. **As in claims 13 and 14**, Garrido teaches of a removable expansion device having a data bus coupled thereto including memory, figure 1 items 80 and 30, column 6 lines 23-36, column 8 lines 57-68. **As in claims 17 and 25**, the Examiner serves Official Notice that said features are well known to be included in joystick circuitry, as sited by Garrido, column 1 lines 20-28. **As in claims 18 and 26** Garrido teaches of wherein instructions in said portable storage device memory control said game in acceleration modes, column 6 lines 20-22, column 6 lines 29-32, column 6 lines 61-68, wherein supplemental speed controls buttons can be inherent to video game design in both modes. **As in**

claims 20-22 Garrido teaches of said removable expansion device, figure 1 item 80, column 6 line 23-36. **As in claim 30 and 31** Garrido teaches wherein instructions in said memory media control said game program executing processing system to output a command to the controller, column 6 lines 23-36.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 29, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrido (5451053).

7. **As in claims 29, 32, and 33**, Garrido teaches of the invention as applied to claim 27. Further the distinctive motion characteristic being maximum speed, calculating the moving speed in response to

joystick inclination, and comparative speeds in relation to a previous frame, are well known in art of video game systems and would have been obvious to the skilled artisan. Said video game controller as taught by Garrido for use within a video game system is a reconfigurable video game controller with all the advantages of the prior art, column 1 lines 45-56. Video games incorporating speed control into the controller joystick as well as controller action buttons are well known as sited in the prior art of record, as sited by Garrido, column 1 lines 20-30, column 5 lines 55-68, column 6 lines 20-22. The Examiner Serves Official Notice that said limitations are well known.

8. **Claims 12 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrido (541053) in view of Reed et al. (5577735).**

9. **As in claims 12 and 28**, Garrido teaches of the invention as applied to claims 11 and 27 above. However Garrido is silent as to said well known joystick selection of player controlled objects for game play. Reed et al. teaches of said well known joystick selection of player controlled objects for game play, column 6 lines 33-34. It would have been obvious to the skilled artisan to utilize said joystick selection means as taught by Reed et al. , given its well known application for selection in video games, in addition to the fact that said joystick serves as the primary data input means for controller video game input, making it the obvious player controlled selection tool of choice.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 15, 16, 23, and 24 rejected under the judicially created doctrine of double patenting over claims 1, 8, 11, and 31 of U. S. Patent No. 5903257 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: "said reset signal generating means in connection with said joystick".

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hsu (5769719) , See figure 1 items 11, col. 1 lines 45-67, col. 4 lines 57-63.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **David L. Lewis** whose telephone number is **(703) 306-3026**. The examiner can normally be reached on MT and THF from 8 to 5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala, can be reached on (703) 305-4938. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

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Or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-6606 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Or hand-delivered to:

Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

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TECHNOLOGY CENTER 2700